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(54) Title: METHOD AND APPARATUS FOR DOCUMENTING USE OF A TRADEMARK OR SERVICE MARK

(57) Abstract:

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**TITLE OF THE INVENTION**  
**METHOD AND APPARATUS FOR DOCUMENTING USE OF A**  
**TRADEMARK OR SERVICE MARK**

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**TECHNICAL FIELD**

The present invention relates to the field of trademarks and service marks; more specifically, it relates to a method and apparatus for establishing legal rights to a trademark or service mark via a global information network.

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**BACKGROUND ART**

A trademark is a word, phrase, sound, color, symbol, design, or other indicator of source, or a combination thereof, which identifies and distinguishes the source of the goods of one party from those of others. A service mark is a word, phrase, symbol, sound, color, design, or other indicator of source, or a combination thereof, which identifies and distinguishes the source of the services of one party from those of others. Together, trademarks and service marks are called marks. Marks can have extremely high economic value, and are an important aspect of brand recognition. Well known examples include the classic Campbell soup red and white label, the Hershey Kiss design, the Morton Umbrella Girl, and the McDonald's Golden Arches.

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In 1998, there were 1,697,620 new applications for service mark and trademark registrations worldwide, according to the World Intellectual Property Organization statistics. That number is expected to approach 3,000,000 for the year 2000. The 1998 and estimated 2000 numbers for the United States are about 250,000 and 450,000, respectively. The above statistics are only for registrations at the national level. In addition, registration systems exist at the sub-national level. For example, in the United States, registration is possible at the state level, independent of any national registrations.

Each country and each state have their own rules regarding trademark registration. However, the United States system is not atypical, and will be discussed in detail to illustrate several key concepts.

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In the United States, federal registration is not required to establish rights in a mark, nor is it required to begin use of a mark. However, federal registration can secure benefits beyond the rights acquired by merely using a mark. For example, the owner of a federal registration is presumed to be the owner of the mark for the goods and services specified in the registration, and to be entitled to use the mark nationwide.

There are two related but distinct types of rights in a mark: the right to register and the right to use. Generally, the first party who either uses a mark in commerce or files an "Intent to Use" application in the United States Patent and Trademark Office (USPTO) has the ultimate right to register that mark (assuming there are no other marks previously registered such that registration of the new mark would be likely to cause confusion or to deceive the public). The USPTO's authority is limited to determining the right to register. The right to use a mark can be more complicated to determine. This is particularly true when two parties have begun use of the same or similar marks without knowledge of one another and neither has a federal registration. Only a court can render a decision about the right to use, such as issuing an injunction or awarding damages for infringement. It should be noted that a federal registration could provide significant advantages to a party involved in a court proceeding.

An application for federal registration of a mark in the United States ultimately requires the applicant to specify: 1) First use of the mark anywhere, and 2) First use of the mark in commerce that is regulated by the U.S. Congress (use in "commerce" under Article III of the U.S. Constitution, e.g., interstate commerce, commerce with an Indian reservation, commerce with a foreign nation, etc.).

Conventionally, "first use anywhere" for a trademark means that the product bearing the mark has been shipped. It doesn't require an actual sale. As stated by P. Gima and S. Elias in *The Trademark Registration Kit: Register Your Trademark Without a Lawyer* (Nolo, 1999, page 2/3): "For products, your mark is in use if the mark appears on the goods or on labels or tags attached to them, and the goods have either been shipped to a store for sale or use as a sample, or are available for sale by mail or over the Internet." "For services, your mark is in use if the services are

actually being marketed under the mark and you can legitimately deliver them to end users." The marketing of services over a global information network probably qualifies for first use anywhere.

Commerce that is regulated by the U.S. congress includes shipping goods interstate, shipping goods out of the country, or using the mark to advertise services outside of a state or advertise services that cater to interstate or international travelers.

Importantly, the date of first use anywhere is what establishes the beginning of one's legal right to a mark. Under the common law, trademark rights arise from use. He or she who is first to use a mark in commerce in a particular territory enjoys superior rights to those who use a confusingly similar mark in that territory thereafter. Therefore, it is important to document the first use of a mark. This is important not only for the registration process but also in case one becomes involved in a trademark dispute.

In practice, many companies postpone trademark and service mark registration for long periods of time even as they continue to use the marks on their goods or services and continue to invest in building brand recognition around those unregistered marks. As time goes by, it becomes more and more difficult to prove a specific date of first use of the mark, and companies must often rely on approximate dates.

Failure to document dates of first use and use in commerce is so problematic that the USPTO *Trademark Manual of Examining Procedure* contains a section (Chapter 900 section 904.07) addressing the issue of indefinite dates of use in trademark applications. The section, entitled "Indefinite Dates of Use," includes the following statement: "When a month and year are given without a specified day, the date presumed is the last day of the month. When only a year is given, the date presumed is the last day of the year." It is further stated: "This presumption may be applicable to a determination of the applicant's rights ...."

As a prerequisite to registration of a mark, an applicant must submit a specimen of the mark as it is used in commerce. For goods (trademarks), acceptable specimens include labels, tags, or containers showing the mark, or a photograph of a

product bearing the mark. Requirements of a specimen are outlined in the above-mentioned USPTO trademark manual of examination procedure, and in 37 CFR §§2.56, 2.59. Also acceptable is any catalog or similar specimen as a display associated with the goods, provided that (1) it includes a picture of the relevant goods, (2) it includes the mark sufficiently near the picture of the goods to associate the mark with the goods, and (3) it includes information necessary to order the goods. Any form of advertising that satisfies these criteria is considered a display associated with the goods. For services (service marks), acceptable specimens include a variety of advertising and marketing materials such as newspaper and magazine ads, brochures, billboards, direct mail pieces and restaurant menus.

#### Legal Analysis

Title 15, Section 1127 provides the legal definition of "use in commerce", a prerequisite for federal registration. Prior to November 16, 1989, use of the mark in commerce was required even to apply for federal registration. Now, the applicant need only have a bona fide intention to use the mark in commerce, although use in commerce is still required for registration. Interestingly, "use in commerce" is defined differently for trademarks and service marks, as explained herebelow:

#### Use in Commerce Requirement for Trademarks

15 U.S.C. §1127 provides, in pertinent part:

"... a mark shall be deemed to be in use in commerce -

(1) on goods when -

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce ..."

#### Use in Commerce Requirement for Service Marks

15 U.S.C. §1127 provides, in pertinent part:

"... a mark shall be deemed to be in use in commerce -

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services."

Thus, it is seen that the "use in commerce" requirements are different for trademarks and service marks. For trademarks, the mark must be placed on the goods or their containers or displays associated therewith AND the goods must be sold or transported in commerce. Advertising does not usually satisfy the use requirement for trademarks. On the contrary, for service marks, advertising of services using the mark does suffice, so long as the services are also rendered in more than one State or in the United States and a foreign country.

The law is presently evolving as to the effect of posting a trademark or service mark on a web site vis-a-vis the "use in commerce" requirement. It is interesting to note that the Lanham Act includes only one definition for "use in commerce" (15 U.S.C. §1127 cited above) and that this definition arguably applies both in the case of one applying for federal registration of a mark, and to determine if an infringer uses an infringing mark "in commerce" for purposes of remedies provided by the Lanham Act. There has been some speculation that, despite the single definition in the Lanham Act, the USPTO applies a higher standard for registration than do the courts in infringement actions. Nevertheless, as of the time of filing of the application for this patent, no court has directly ruled on whether posting of a trademark or service mark on a web site would satisfy the "use in commerce" requirement of 15 U.S.C. §1127 as it applies to registration. Courts have, however, come close to addressing the issue in right to use proceedings.

In *Intermatic v. Toeppen*, 41 USPQ2d 1223 (N.D. Ill. 1996), an alleged cybersquatter raised as a defense that ownership and use of a domain name was not "use in commerce" under the Lanham Act, and that Section 43(c) of the Lanham Act didn't apply. In rebutting this argument, the Court stated, "Toeppen's use of the Internet satisfies the 'in commerce' requirement of Section 43(c). Toeppen also argues

that he has not violated the Act because his use of the 'intermatic.com' domain name was not in commerce. This argument misses the mark. 'Because Internet communications transmit instantaneously on a worldwide basis there is little question that the 'in commerce' requirement would be met in a typical Internet message, be it trademark infringement or false advertising.'" (citing 1 Gilson, Trademark Protection and Practice, §5.11[2], p.5-234 (1996).) It is interesting that the Court didn't say that such Internet use would satisfy the "in commerce" requirement for federal registration, but, since there is only one definition of use in commerce in the Lanham Act, presumably such use would qualify as use in commerce for federal registration.

10 In *Planned Parenthood Federation of America Inc. v. Bucci*, 42 USPQ2d 1430 (S.D.N.Y. 1997), the defendant Bucci registered the domain name "plannedparenthood.com" and the plaintiff, Planned Parenthood Federation of America Inc. sued to enjoin the defendant from using the domain name. The court, citing the Intermatic v. Toeppen case, supra, acknowledged that courts sometimes  
15 apply a different "use in commerce" standard for infringement activity than the PTO uses under §1127 for purposes of qualifying for federal registration in the first instance, but nevertheless concluded that the defendant's use of the domain name qualified as "use in commerce" under §1127.

As use of the Internet proliferates, and as more and more goods and services  
20 are advertised and made available via the Internet, it is logical to assume that the USPTO and the courts will eventually recognize web site postings of trademarks and service marks as "use in commerce" under 15 U.S.C. §1127.

There has been a long felt need, then, for a method and apparatus to facilitate and unambiguously document the date of first use of a trademark or service mark. In  
25 addition, a system and method is needed for unambiguous documentation of date of first use in commerce of a trademark or service mark.

#### DISCLOSURE OF INVENTION

Internet sites are widely used to advertise goods and services, as well as to  
30 serve as points of sale ("virtual storefronts") for goods and services. At virtual

storefront web sites, a customer can generally order or find out how to order goods or services. In addition, customers can often search for and conduct research into goods and services at a virtual storefront web site.

5 The present invention comprises a method of documenting first use of a trademark including the steps of posting the trademark in a virtual storefront file accessible over a global information network, retrieving the storefront file, rendering the retrieved storefront file into a storable file format, storing the rendered retrieved storefront file in a memory, and notarizing the rendered retrieved storefront file to document a date and time of first use of the trademark. The invention also includes an  
10 apparatus to implement the method. The invention includes the steps of digitally notarizing a web page, web site, or portion of a web site in order to provide proof that the content was present at the web site on a particular date. In particular, an Internet-based advertisement for goods and services which uses a trademark or service mark, or an Internet-based "virtual storefront" which uses a trademark of service mark, is  
15 digitally notarized to provide proof that the trademark or service mark was in use at a given time and in a specific manner.

More specifically, the present invention utilizes a documentation process to initiate notarization of a client's web pages that utilize marks in conjunction with advertisements or commercial offers. The documentation process comprises a mark  
20 database. Electronic records of the web page content and the notarization data are stored in a mark database, and can optionally be provided to the client.

Thus, one object of the invention is to provide a system and method to unambiguously prove that a mark was in use or in use in commerce, both of which are important events in establishing rights to a mark.

25 Another object of the invention is to provide a system and method for creating reliable specimens to be used in applications for registration of marks.

Other benefits and advantages of the present invention will become apparent upon a reading of the following detailed description in view of the drawings and appended claims.



### BRIEF DESCRIPTION OF DRAWINGS

Figure 1 is a representative diagram of one embodiment of the system of the present invention for establishing legal rights to a trademark or service mark via a global information network;

5        Figure 2 is a representative diagram of a second embodiment of the system of the present invention for establishing legal rights to a trademark or service mark via a global information network;

Figure 3 is a representative diagram of a third embodiment of the system of the present invention for establishing legal rights to a trademark or service mark via a  
10        global information network; and,

Figure 4 is a representative diagram of one embodiment of the method of the present invention for establishing legal rights to a trademark or service mark via a global information network.

### 15        MODES FOR CARRYING OUT THE INVENTION

#### Glossary of Terms and Acronyms

The following terms and acronyms are used throughout the detailed description:

20        *Mark.* A trademark or service mark, or any similar indicator of source or origin of a good or service, respectively.

*Global Information Network.* Any computer network, and, in a preferred embodiment, the Internet.

*Data file.* A collection of bits and bytes that has a name, called the filename. Most information stored in a computer must be in a data file.

25        *Email (Electronic mail).* The transmission of messages over communications networks. The messages can be notes entered from the keyboard or electronic files stored on disk.

*FTP.* File Transfer Protocol, the protocol used on a global information network for sending files.

*HTML*. HyperText Markup Language, which defines the structure and layout of a Web document by using a variety of tags and attributes. Computer software codes for attaching presentation and linking attributes to informational content within documents. Documents sent to the Web browser contain HTML codes (referred to as "tags") embedded within the informational content of the document. When the Web document (or HTML document) is subsequently received by a Web browser, the codes are interpreted by the browser and used to parse and display the document. Additionally HTML tags can be used to create links to other Web documents (commonly referred to as "hyperlinks").

*HTTP (HyperText Transfer Protocol)*. The standard World Wide Web protocol used for the exchange of information (such as HTML documents, and Web browser requests for such documents) between a browser and a Web server. HTTP includes a number of different types of messages which can be sent from the client to the server to request different types of server actions. For example, a "GET" message, which has the format GET, causes the server to return the document or file located at the specified URL. In the present invention, HTTPS (secure HTTP) may be used instead of HTTP if secure transmission is desired.

*Hyperlink*. A navigational link from one document to another that can be selected by clicking on it using a mouse, which causes the Web browser to display the linked document.

*Internet*. A collection of interconnected public and/or private networks that are linked together by a set of standard protocols such as TCP/IP and HTTP, to form a global, distributed network. The term "Internet" is also intended to encompass changes and additions to existing standard protocols that may be made in the future.

*Notarization*. The process of validating or attesting a legal document. Digital notarization is a process whereby the contents of a computer file, including a web page, can be digitally validated and attested.

*Online form*. A formatted document containing blank fields that users can fill in with data via a web browser over a global information network. The form appears on the user's display screen and the user fills it in by selecting options with a pointing

device or typing in text from the computer keyboard. The data can then be sent directly to a forms processing application (program), which enters the information into a database or otherwise utilizes the information. Online forms are common on the World Wide Web because the HTML language has built-in codes for displaying form elements such as text fields and check boxes. Typically, a CGI program processes the data entered into a Web-based form.

*Render.* To produce a facsimile or reproduction of a displayed file by converting the browser or other screen display of the file to a different file format. An example is creating a PDF file from a web page displayed on a browser, in which case the web page is rendered as a PDF file.

*Server.* A computer or device on a network that manages network resources. For example, web server is a computer that delivers (serves up) Web pages. Every Web server has an IP address and possibly a domain name. For example, if you enter the URL `http://www.xyz.com/index.html` in your browser, this sends a request to the server whose domain name is `xyz.com`. The server then fetches the page named `index.html` and sends it to your browser. Most computers can be turned into a Web server by installing server software and connecting the machine to a global information network.

*Upload.* To transmit data from a computer to a bulletin board service, mainframe, or network. For example, if you use a personal computer to log on to a network and you want to send files across the network, you must upload the files from your PC to the network.

*URL (Uniform Resource Locator).* A unique address which fully specifies the location of a file or other resource on a global information network. The general format of a URL is `protocol://machine address:port/path/filename`. The port specification is optional.

*Web browser.* A program which sends requests to another program in a distributed system in which a program at one site sends a request to a program at another site and waits for a response. Typically the Web browser receives Web pages or files from a server. The two most popular browsers are Netscape Navigator and

Microsoft Internet Explorer. Both of these are graphical browsers, which means that they can display graphics as well as text.

*Web page.* A document on the World Wide Web. Every Web page is identified by a unique URL (Uniform Resource Locator).

5        *Web site.* A computer system for serving informational content over a network using the standard protocols of the World Wide Web. Typically, a Web site corresponds to a particular Internet domain name, such as "IP.COM," and includes the content associated with a particular organization. As used herein, the term is generally intended to encompass both the hardware/software server components that serve the  
10 informational content over the network, and additional hardware/software components, including any non-standard or specialized components, that interact with the server components to perform services for Web site users.

*World Wide Web ("Web").* A distributed collection of interlinked, user-viewable hypertext documents, commonly referred to as Web documents or Web  
15 pages, that are accessible via a global information network. Currently, the primary standard protocol for allowing applications to locate and acquire Web documents is HTTP, and the Web pages are encoded using HTML. The term "Web" is also intended to encompass changes and additions to existing standard protocols that may be made in the future.

## 20    Apparatus and Method

      Figure 1 illustrates one embodiment of the apparatus of the present invention. The apparatus of the invention broadly comprises virtual storefront **100**, operatively arranged to permit a client to use a mark in one or more storefront files **110**. The storefront files are either web pages, emails, or data files containing information  
25 pertaining to goods or services for sale (referred to hereinafter as goods and services information). For example, the goods and services information can include descriptions of goods or services, prices, specifications, pictures or other graphics files, or any other information useful to include in advertisements, catalogues, commercials, or sales brochures. In addition, the goods and services information in at  
30 least one storefront file **110** would include a mark.

Referring again to Figure 1, a documentation process 200 is implemented by web server 210. Web server 210 is operatively arranged to run computer program 220 on web server 210, and mark database 230 is accessible by computer program 220. Computer program 220, via web server 210, is operatively arranged to retrieve storefront files 110 from the virtual storefront 100, via storefront web server 120. Computer program 220 is arranged to render storefront files 110 to a file format that can be conveniently stored in mark database 230. (As examples of rendering, computer program 220 can convert a storefront file 110 to PDF, MHT, HTML, JPG, TIF, GIF, or other file format that enables the content relayed in original storefront file 110 to be more conveniently notarized or stored in temporary storage 240 or in mark database 230.) The rendered file is then stored in temporary storage 240 or in mark database 230. Computer program 220 is also operatively arranged to initiate notarization via web server 210.

Notarization process 300 is described in United States Patent Application Serial No. 09/625,185, filed July 21, 2000, incorporated herein by reference; in corresponding Continuation-in-Part United States Patent Application Serial No. 09/655,951, filed September 6, 2000, incorporated herein by reference; in corresponding Continuation-in-Part United States Patent Application Serial No. 09/705,975, filed November 3, 2000, incorporated herein by reference.

After notarization, a notary file is returned to documentation process 200 via notary web server 310. The notary file is stored in mark database 230 along with the rendering of storefront files 110, creating a database record that can be used to document use of a mark.

It should be noted that in the embodiment shown in Figure 1, virtual storefront 100 and documentation process 200 reside at distinctly separate physical locations and are connected via global information network 400. In the preferred embodiment shown in Figure 1, the global information network is the Internet.

Figure 2 illustrates a second embodiment of the system, wherein storefront computer program 510 is operatively arranged to implement documentation process 500. In the embodiment of Figure 2, a client uses a mark in one or more storefront

files **520** within documentation process **500**. Storefront files **520** are either web pages, emails, or data files containing information pertaining to goods or services for sale (goods and services information). For example, the goods and services information can include descriptions of goods or services, prices, specifications, pictures or other graphics files, or any other information useful to include in advertisements, catalogues, commercials, or sales brochures. In addition, the goods and services information in at least one of storefront files **520** would include a mark.

Referring again to Figure 2, documentation process **500** is implemented by computer program **540**, running on web server **530**, and mark database **560** which is accessible by computer program **540**. Computer program **540** is operatively arranged to interact with storefront computer program **510** to retrieve storefront files **520**. Computer program **540** is also arranged to render storefront files **520** to a file format that can be conveniently stored in mark database **560**. (As examples of rendering, computer program **540** on web server **530** can convert storefront files **520** to PDF, MHT, HTML, JPG, TIF, GIF, or other file formats that enable the content relayed in the original storefront files **520** to be more conveniently notarized or stored.) The rendering is then stored in temporary storage **580** or in mark database **560** within documentation process **500**, and computer program **540** then initiates notarization via web server **530**. Notarization process **300** is the same as that described above in reference to Figure 1.

After notarization, a notary file is returned to documentation process **500** via notary web server **310**. The notary file is stored in mark database **560** along with the rendering of storefront files **520**, creating a database record that can be used to document use of a mark.

Figure 3 illustrates a third embodiment of the system, wherein storefront computer program **610** implements documentation process **600** on storefront web server **620**. In the embodiment of Figure 3, a client uses a mark in one or more storefront files **630** within documentation process **600**. The storefront files **630** are of the same type as those described in Figures 1 and 2. They are either web pages, emails, or data files containing information pertaining to goods or services for sale

(goods and services information). For example, the goods and services information can include descriptions of goods or services, prices, specifications, pictures, or any other information useful to include in advertisements, catalogues, commercials, or sales brochures. In addition, the goods and services information in at least one of the storefront files **630** would include a mark.

Referring again to Figure 3, documentation process **600** in this embodiment is implemented by computer program **660** running on web server **640**, and mark database **680**, which is accessible by computer program **660**. Computer program **660** is operatively arranged to interact with storefront computer program **610** to retrieve storefront files **630**. In addition, storefront computer program **610** is linked to storefront web server **620**, enabling computer program **660** to access storefront computer program **610** via web server **620** and storefront web server **640**. This ensures and documents that storefront files **630** are actually accessible via a global information network **400**. After retrieving storefront files **630** from storefront computer program **610**, computer program **660** is arranged to render storefront files **630** to a file format that can be conveniently stored in mark database **680**. (As examples of rendering, computer program **660** on web server **640** can convert storefront files **630** to PDF, MHT, HTML, JPG, TIF, GIF, or other file formats that enable the content relayed in the original storefront files **630** to be more conveniently notarized or stored.) The rendering is then stored in temporary storage **686** or in mark database **680** within documentation process **600**, and computer program **660** then initiates notarization via web server **640**.

Notarization process **300** is the same as that described above in reference to Figures 1 and 2.

After notarization, a notary file is returned to documentation process **600** via notary web server **310**. The notary file is stored in mark database **680** along with the rendering of storefront files **630**, creating a database record that can be used to document use of a mark.

Figure 4 illustrates the preferred embodiment of the method of the present invention. The client creates a virtual storefront display (one or more storefront files)

comprising a mark. The computer program on a server then creates a rendering of the virtual storefront display and initiates notarization of the rendering. The rendering is then notarized, and notary information is stored, along with the rendering, in the mark database.

Printouts of the renderings stored in the mark database can be used as specimens in trademark and service mark registration applications.

In one embodiment of the invention, banner ads are used to advertise recently listed goods or services. Any such banner ad is hyperlinked so that when a user clicks on it the user is taken to a web page displaying contents of storefront files **110**, **520**, or **630**, or will be taken to a page that has a listing or search function providing additional hyperlinks to various goods or services for sale. The banner ads are displayed by web server **210**, **520**, or **630**. Alternatively they can be displayed by storefront web server **620** or on any other web server or web site.

15 In another embodiment, goods or services that are for sale will be listed in email and distributed via email mailing lists. For example, new customers or clients of the service provider who run documentation processes **200**, **500**, or **600** may become members of the mailing list, said mailing list members receiving periodic updates of new goods and services offers.

The invention will now be described by the following non-limiting examples.

20 Example 1

Company XYZ offers an Internet-based service (virtual storefront) whereby clients can list and display, in an Internet store, goods and services that are for sale. A client, ABC Company, wishing to list a new item, logs onto Company XYZ's web site (web server) to provide input to online forms and upload data, thereby creating virtual storefront files (storefront files) that web users will be able to access via a global information network. In the present example, the client (Company ABC) wishes to use a new trademark (mark A) in conjunction with jars of jelly beans sold by Company ABC. Company ABC, after logging into Company XYZ's web site, enters into a form their address, telephone number, a description of the product (jars of jelly beans), and the price of a jar of jelly beans, all of which information will be displayed



when viewers display the jelly bean virtual storefront web page in their browsers. In addition, the client uses the online forms on the web site to upload an image file of a jar of jelly beans to include as a storefront file for display in the virtual storefront web page. Company ABC's trademark ("mark A") is clearly visible on the jar in the image file. Once Company ABC clicks on the upload button, thereby concluding their interactive session at the web site, the computer program on Company XYZ's web server takes the information from the online forms, along with the uploaded image file, and uses the information and image file to create an HTML file (storefront file), said HTML file comprising appropriate HTML tags to display the image of the jar of jelly beans from the image file (also a storefront file). The computer program then accesses the HTML and image files (storefront files) via a global information network, stores them in the mark database, and renders the HTML file, including the image, into a PDF file, which is also stored in the mark database. The computer program then initiates notarization of the PDF file, via a global information network. After notarization, a notary file is returned to the computer program, via a global information network, and is stored in the mark database. The computer program then sends an email message to Company ABC, indicating that the storefront files have been successfully created, and that a PDF rendering of the storefront files has been created and notarized.

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#### Example 2

Company ZZZ has an Internet site (virtual storefront), at which it advertises its accounting services. Each web page at the site clearly displays company ZZZ's service mark. To display web pages at its web site, Company ZZZ's storefront web server accesses various storefront files, including HTML and image files. Company XXX offers a service whereby it provides electronic documentation to verify that a mark is being used at an Internet site. A representative from Company ZZZ, wishing to obtain such documentation for a page at Company ZZZ's web site, logs into Company XXX's web site and submits a request to have the page documented by Company XXX's service. The computer program running on Company XXX's "documentation process" then accesses the indicated web page via a global

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information network at Company ZZZ's web site, renders it as a PDF file, and stores the PDF file in its mark database. The computer program then initiates notarization of the PDF file, via a global information network. After notarization, a notary file is returned to the computer program, via a global information network, and is stored in the mark database. The computer program then sends an email message to Company ZZZ, indicating that a PDF rendering of the storefront files has been created and notarized.

In the claims that follow, it should be understood that the word "trademark" used in the claims is intended to include and mean "service mark", "trade name", "mark" or any other indicator of source or origin of goods and/or services. The phrase "global information network" is intended to include any and all computer networks. In a preferred embodiment, the global information network comprises the Internet. Also in a preferred embodiment, the global information network includes nodes (computers connected to the network) in at least two states of the United States, or at least in one state and a foreign country, or at least one Indian reservation and a state, or in at least two different jurisdictions that would qualify as "use in commerce" under the Lanham Act definition. It should be appreciated, however, that common law trademark rights arise from intrastate use of a mark, and that "use in commerce" under the Lanham Act is not necessary to establish common law rights in a trademark or service mark. Hence, the present invention as claimed is not intended to be limited in scope to documenting "use of a mark in commerce". Although this is preferred, the invention as claimed is also useful in documenting use of a mark anywhere to establish common law rights.

Thus, it is seen that the objects of the invention are efficiently obtained, although changes and modifications to the invention will be readily apparent to those having ordinary skill in the art, and these changes and modifications are intended to be within the scope of the invention as claimed.

## WHAT IS CLAIMED IS:

1. A method of documenting first use of a trademark, comprising:  
posting said trademark in a virtual storefront file accessible over a global  
5 information network;  
retrieving said storefront file;  
rendering said retrieved storefront file into a storable file format;  
storing said rendered retrieved storefront file in a memory; and,  
notarizing said rendered retrieved storefront file to document a date and time  
10 of first use of said trademark.
2. The method of documenting first use of a trademark recited in Claim 1  
wherein said memory is a temporary storage memory device.
3. The method of documenting first use of a trademark recited in Claim 1  
wherein said memory is a database.
- 15 4. The method of documenting first use of a trademark recited in Claim 1  
wherein first use is first use "in commerce" which the Congress of the United States  
of America can regulate under the United States Constitution.
5. The method of documenting first use of a trademark recited in Claim 1  
wherein said rendered retrieved storefront file is in a format selected from the group  
20 consisting of PDF, MHT, HTML, JPG, TIF and GIF.
6. The method of documenting first use of a trademark recited in Claim 1  
wherein said storefront file is located in a location remote from a location where said  
rendering step is performed.
7. The method of documenting first use of a trademark recited in Claim 1  
25 wherein said virtual storefront file is selected from the group consisting of web pages,  
emails and data files.
8. The method of documenting first use of a trademark recited in Claim 1  
wherein said virtual storefront file contains information pertaining to goods or  
services for sale.

9. The method of documenting first use of a trademark recited in Claim 1 wherein said steps of retrieving said storefront file, rendering said retrieved storefront file into a storable file format, and storing said rendered retrieved storefront file in a memory are performed by a computer program operatively arranged to run on a web server.
10. The method of documenting first use of a trademark recited in Claim 1 wherein said step of notarizing said rendered retrieved storefront file to document a date and time of first use of said trademark is performed at a location remote from all other steps in said method.
11. A method of documenting first use of a trademark recited in Claim 1 wherein said storefront file is transmitted from a virtual storefront to a web server over said global information network.
12. A method of documenting first use of a trademark recited in Claim 1 wherein said notarization step creates a notary file, and said notary file is transmitted to a web server via said global information network.
13. A method of documenting first use of a trademark recited in Claim 1 wherein said steps of retrieving, rendering and storing are performed by a computer program running on said web server.
14. A method of documenting first use of a trademark, comprising:  
posting said trademark in a virtual storefront file accessible over a global information network; and,  
implementing an automatic computerized documentation process to document first use of said trademark.

15. A method of documenting first use of a trademark, comprising:  
posting said trademark in a virtual storefront file accessible over a global  
information network;  
retrieving said storefront file;  
5 rendering said retrieved storefront file into a storable file format; and,  
storing said rendered retrieved storefront file in a memory, wherein said stored  
storefront file includes information related to a date and time of first use of said  
trademark.
16. An apparatus for documenting first use of a trademark, comprising:  
10 means for posting said trademark in a virtual storefront file accessible over a  
global information network;  
means for retrieving said storefront file;  
means for rendering said retrieved storefront file into a storable file format;  
means for storing said rendered retrieved storefront file in a memory; and,  
15 means for notarizing said rendered retrieved storefront file to document a date  
and time of first use of said trademark.
17. The apparatus for documenting first use of a trademark recited in Claim 16  
wherein said means for posting said trademark in a virtual storefront file accessible  
over a global information network comprises a general purpose computer specially  
20 programmed to post said trademark in said virtual storefront file.
18. The apparatus for documenting first use of a trademark recited in Claim 16  
wherein said means for retrieving said storefront file comprises a retrieval method that  
use file transfer protocol.
19. The apparatus for documenting first use of a trademark recited in Claim 16  
25 wherein said means for retrieving said storefront file comprises email.
20. The apparatus for documenting first use of a trademark recited in Claim 16  
wherein said means for rendering said retrieved storefront file into a storable file  
format comprises a general purpose computer specially programmed to perform said  
rendering.

21. The apparatus for documenting first use of a trademark recited in Claim 16 wherein said means for storing said rendered retrieved storefront file in a memory comprises a general purpose computer specially programmed to perform said storing.

22. The apparatus for documenting first use of a trademark recited in Claim 16  
5 wherein said means for notarizing said rendered retrieved storefront file to document a date and time of first use of said trademark comprises a general purpose computer specially programmed to perform said notarization.

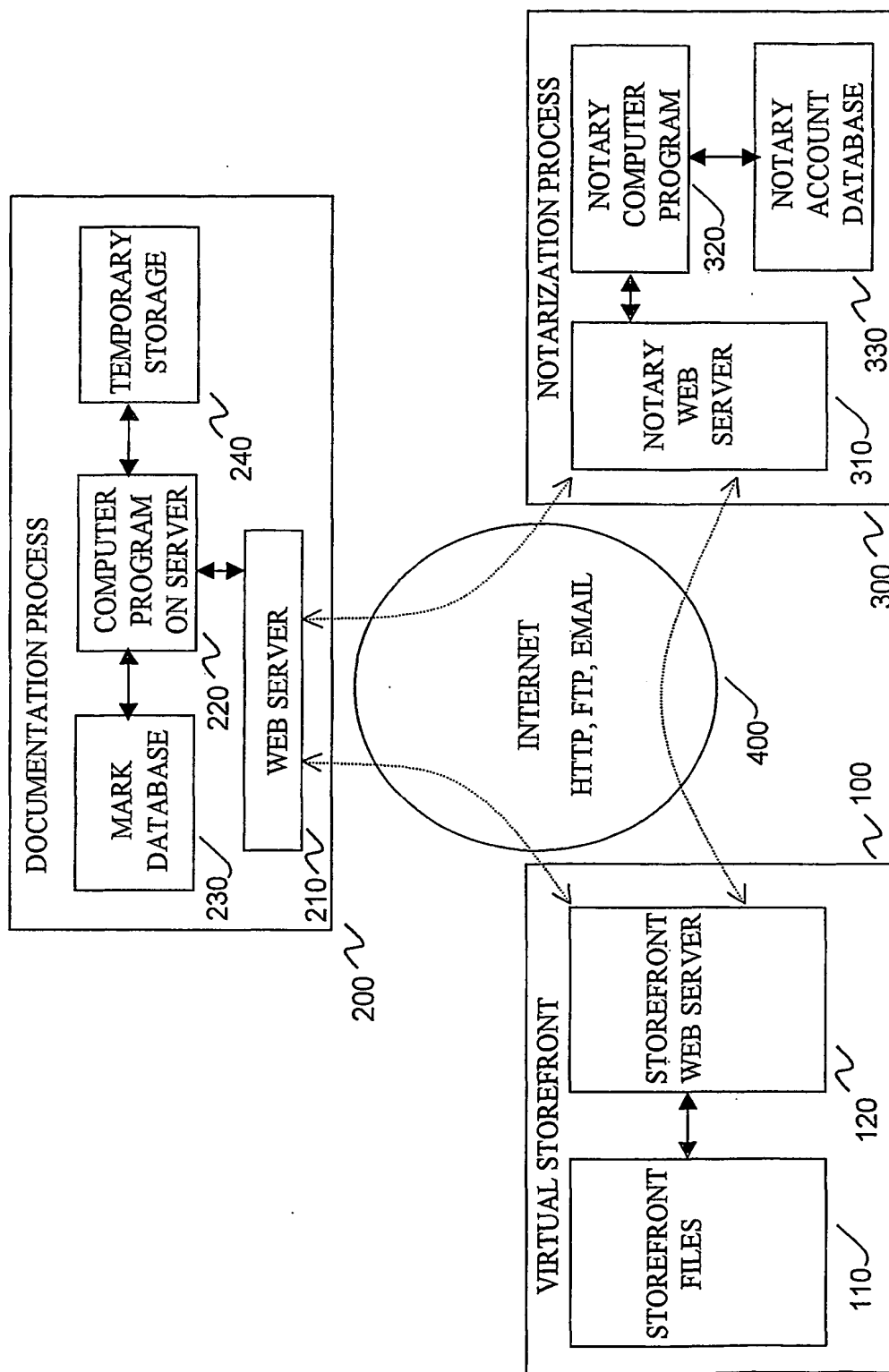


FIG. 1

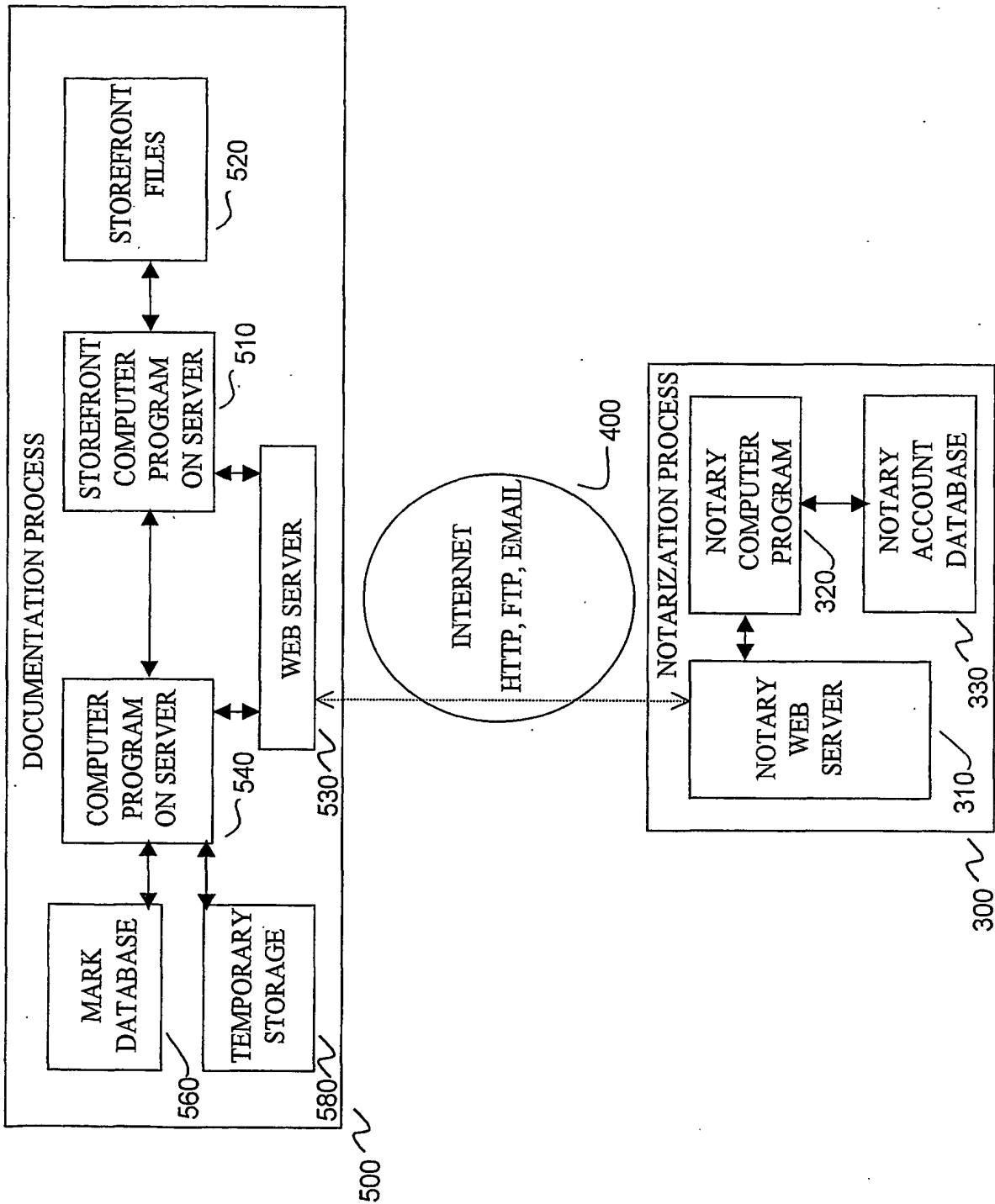


FIG. 2



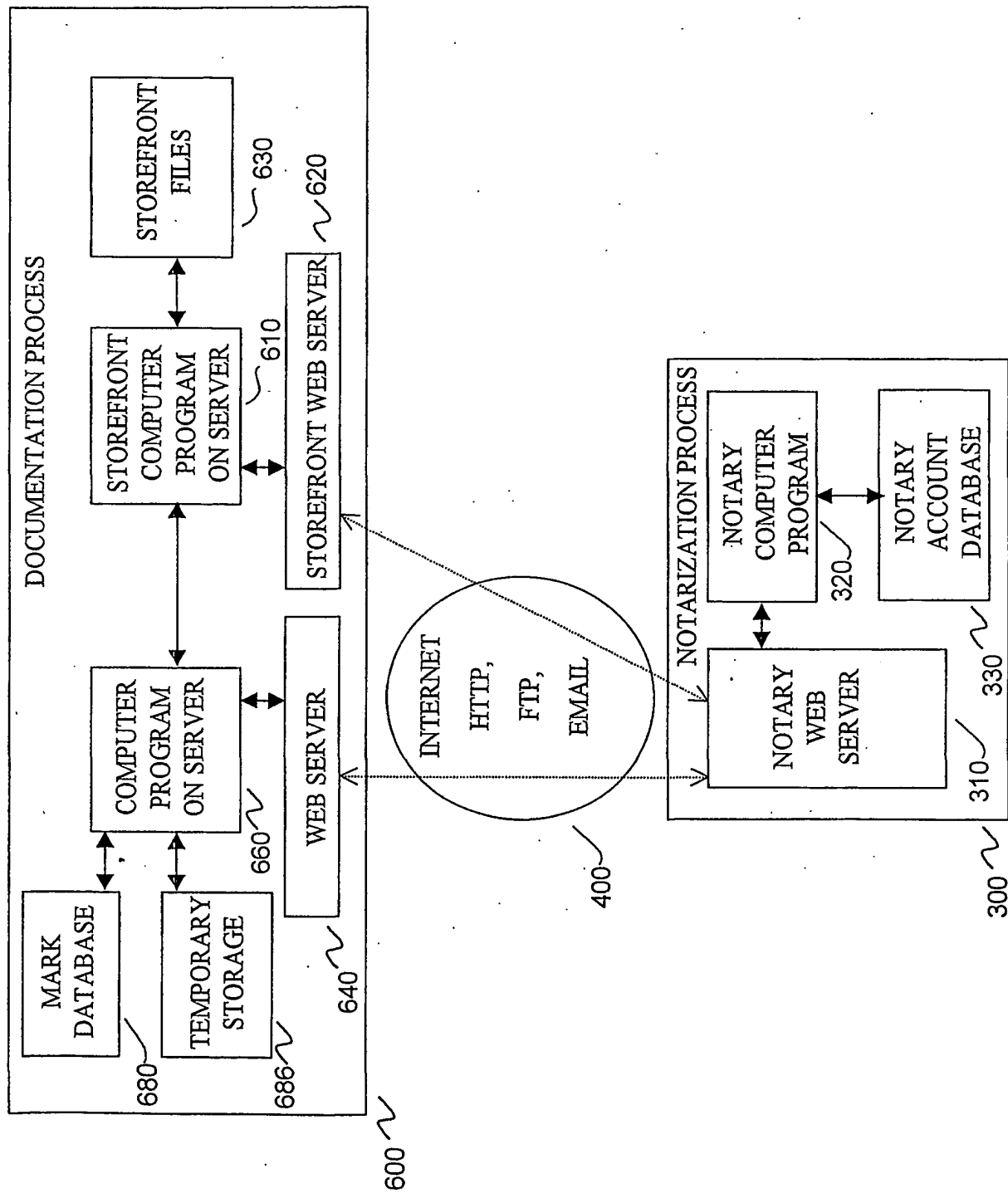


FIG. 2

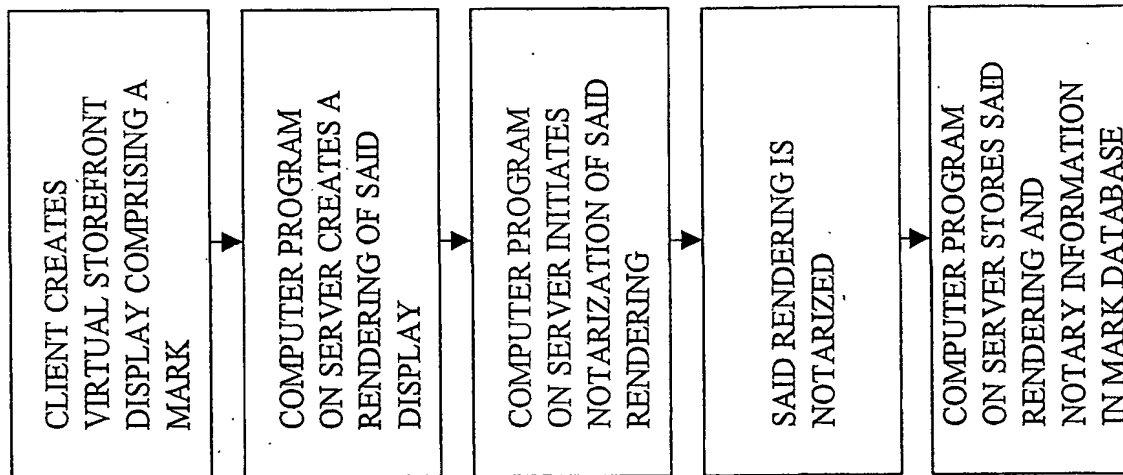


FIG. 4

# PATENT COOPERATION TREATY

# PCT

## DECLARATION OF NON-ESTABLISHMENT OF INTERNATIONAL SEARCH REPORT

(PCT Article 17(2)(a), Rules 13ter.1(c) and Rule 39)


Applicant's or agent's file reference <b>IPCP104WO</b>	IMPORTANT DECLARATION	Date of mailing(day/month/year) <b>25/01/2002</b>
International application No. <b>PCT/US 01/ 14720</b>	International filing date(day/month/year) <b>08/05/2001</b>	(Earliest) Priority date(day/month/year)
International Patent Classification (IPC) or both national classification and IPC <b>G06F17/60</b>		
Applicant <b>IP.COM, INC.</b>		

This International Searching Authority hereby declares, according to Article 17(2)(a), that **no international search report will be established** on the international application for the reasons indicated below

1. ☒ The subject matter of the international application relates to:
  - a. ☐ scientific theories.
  - b. ☐ mathematical theories
  - c. ☐ plant varieties.
  - d. ☐ animal varieties.
  - e. ☐ essentially biological processes for the production of plants and animals, other than microbiological processes and the products of such processes.
  - f. ☒ schemes, rules or methods of doing business.
  - g. ☐ schemes, rules or methods of performing purely mental acts.
  - h. ☐ schemes, rules or methods of playing games.
  - i. ☐ methods for treatment of the human body by surgery or therapy.
  - j. ☐ methods for treatment of the animal body by surgery or therapy.
  - k. ☐ diagnostic methods practised on the human or animal body.
  - l. ☐ mere presentations of information.
  - m. ☐ computer programs for which this International Searching Authority is not equipped to search prior art.
2. ☐ The failure of the following parts of the international application to comply with prescribed requirements prevents a meaningful search from being carried out:
 

☐ the description
☐ the claims
☐ the drawings
3. ☐ The failure of the nucleotide and/or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative Instructions prevents a meaningful search from being carried out:
 

☐ the written form has not been furnished or does not comply with the standard.
 ☐ the computer readable form has not been furnished or does not comply with the standard.
4. Further comments:

Name and mailing address of the International Searching Authority  European Patent Office, P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk Tel. (+31-70) 340-2040, Tx. 31 651 epo nl, Fax: (+31-70) 340-3016	Authorized officer
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## FURTHER INFORMATION CONTINUED FROM PCT/ISA/ 203

The claims relate to subject matter excluded from patentability under Art. 52(2) and (3) EPC. Given that the claims are formulated in terms of such subject matter or merely specify commonplace features relating to its technological implementation, the search examiner could not establish any technical problem which might potentially have required an inventive step to overcome. Hence it was not possible to carry out a meaningful search into the state of the art (Rule 45 EPC). See also Guidelines Part B Chapter VIII, 1-6.

The applicant's attention is drawn to the fact that claims relating to inventions in respect of which no international search report has been established need not be the subject of an international preliminary examination (Rule 66.1(e) PCT). The applicant is advised that the EPO policy when acting as an International Preliminary Examining Authority is normally not to carry out a preliminary examination on matter which has not been searched. This is the case irrespective of whether or not the claims are amended following receipt of the search report or during any Chapter II procedure. If the application proceeds into the regional phase before the EPO, the applicant is reminded that a search may be carried out during examination before the EPO (see EPO Guideline C-VI, 8.5), should the problems which led to the Article 17(2) declaration be overcome.